

## REMARKS

Claims 1-7 and 9-21 are pending.

### Regarding Rejections:

5        Claims 1-3, 7, 9, 11, 12, and 16-21 stand rejected under 35 U.S.C 102(e) as being  
anticipated by US Patent No. 6,980,312 issued to Czyszczewski et al. (Czyszczewski).  
Applicant traverses these rejections for at least the following reasons and in doing so  
further respectfully requests that the Examiner reconsider and withdraw the rejection.

"A claim is anticipated only if each and every element as set forth in the claim  
10 is found, either expressly or inherently described, in a single prior art reference."  
*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051,  
1053 (Fed. Cir. 1987).

Independent Claim 1 recites a method for use with a unitary device. The  
method includes (*emphasis added*):

15        with *a unitary device* comprising therein logic, a user interface, *a*  
*scanning mechanism*, a communication interface, and a removable data  
storage mechanism, wherein said logic is operatively coupled to said user  
20 interface to receive an inputted recipient electronic mail address, to said  
scanning mechanism to receive at least scanned object data obtained by  
optically scanning an object, to said communication interface to send an  
electronic mail message that includes at least a portion of said scanned object  
data to a remote device associated with said recipient electronic mail address,  
and to said removable data storage mechanism to access therethrough a  
25 removable data storage media when present:  
              *receiving a removable data storage media in said removable*  
              *data storage mechanism;*  
              *selectively operatively coupling said removable data storage*  
              *media to said logic ; and*  
30        *storing at least an archival copy of at least said electronic*  
*mail message data sent via the communication interface on said*  
*removable data storage media.*

The Office Action asserts that *Czyszczewski* discloses such a method, however, a  
35 careful inspection reveals that this assertion is incorrect because *Czyszczewski* does not

disclose or even reasonably suggest each and every element, either expressly or inherently, as set forth in Claim 1.

For example, *Czyszczewski* fails to disclose *a unitary device* that includes *a scanning mechanism* as specifically recited in Claim 1. Instead, *Czyszczewski* discloses  
5 multifunction controller 25 that is coupled to at least one scanner 20 through a communication link 30 (see, e.g., Fig. 1). Thus, *Czyszczewski* teaches that the scanner 20 is not part of a unitary device, but rather a separate, stand-alone device. Indeed, *Czyszczewski* at column 5, lines 45-48, points out the advantages coupling their multifunction controller 25 to commercially available or already existing scanners  
10 through standard interfaces. Hence, *Czyszczewski* fails to disclose or otherwise suggest a unitary device including a scanning mechanism as specifically recited in Claim 1. Moreover, *Czyszczewski* actually teach away from such a unitary device.

It is important to note that while *Czyszczewski* states that Fig. 1 shows a “multifunction device 10”, what is actually shown and described is not really a “device”  
15 at all but rather an operating environment or system because it shows a several separate and clearly stand-alone devices and/or systems that are interconnected via communication links and/or networked resources. For example, the scanner(s) are clearly separate devices, as are the “local multiple printers 43”, the “global remote printers 53”, the “global services (e-mail, Fax, print directory, security, library) 55”, the  
20 “global network 50”, and the “local network 45”. Consequently, “multifunction device 10” is simply not a unitary device, but instead an operating environment or system of networks and networked computing resources.

In yet another example, *Czyszczewski* fails to disclose *a unitary device* that includes *a removable data storage mechanism* as recited in Claim 1. *Czyszczewski*  
25 does disclose that multifunction controller 25 may include a CPU 80 and RAM 85 and that programming instructions may be loaded from “one or more disk drives” into RAM 85 (see, e.g., column 6, lines 20-23). However, it is unclear if a “disk drive” as

mentioned only on line 21 of column 6 does or does not include *a removable data storage mechanism*. Given this uncertainty, it seems unreasonable to assert that Czyszczewski somehow discloses or otherwise suggests the recited acts in Claim 1 of “*receiving a removable data storage media in said removable data storage*  
5 *mechanism*”, and “*selectively operatively coupling said removable data storage media to said logic*”.

Assuming for arguments sake that the “disk drive” in Czyszczewski’s multifunction controller 25 can be construed to include *a removable data storage mechanism*, it is still clearly incorrect to assert that Czyszczewski discloses or somehow  
10 suggests the recited act in Claim 1 of “*storing at least an archival copy of at least said electronic mail message data sent via the communication interface on said removable data storage media*”. Note that Czyszczewski does not mention nor suggest that any data is written to the “disk drive” -- Czyszczewski only teaches that operating instructions for the CPU may be loaded from the “disk drive” into memory.

15 Moreover, with regard to electronic mail Czyszczewski teaches only that one of the functions that the multifunction controller 25 can support is that e-mails can be sent out through an e-mail port using “optional local services 135” and/or “optional global services 55”. Czyszczewski simply does not mention storing copies of the outgoing e-mails or any other types of data to the “disk drive” of multifunction controller 25.  
20 Czyszczewski does teach that the multifunction controller 25 may be used to dynamically access a “remote datastore 150” (see, e.g., Column 10, lines 34-30) and either fax, e-mail, or print documents stored in a remote device, for example, as provided as part of “optional local services 25” and/or “optional global services 55”. This type of multiple networked device remote database document retrieval process is clearly different than  
25 the method as recited in Claim 1 in which *a unitary device stores an archival copy of an electronic mail message data sent on a removable data storage media*.

Thus, for at least these reasons, Claim 1 and Claims 2-3, 7, 9, and 21, which depend there from, are clearly patentable over *Czyszczewski*.

5 Similarly, independent Claim 11 is directed towards *a unitary device* that includes (*emphasis added*):

10 *a data storage mechanism configurable to access a removable data storage media,*  
*an optical scanning mechanism* configurable to optically scan at least one object and produce corresponding scanned object data,  
a communication interface configurable to operatively connect to at least one other device over at least one network,  
15 a user interface configurable to receive user inputs, and  
logic operatively coupled to said data storage mechanism, said optical scanning mechanism, said communication interface, and said user interface, wherein said logic is configured to combine recipient electronic mail address data received through said user interface with at least a portion of said scanned object data to form electronic mail message data that is then output by said communication interface, and *wherein said logic is further configured to*  
20 *selectively archive at least a portion of said electronic mail message data by providing said portion of said electronic mail message to said data storage mechanism for storage on said removable data storage device.*

25 The Office Action asserts that *Czyszczewski* discloses such a unitary device, however, as illustrated in the examples above with respect to Claim 1 more detailed inspection of the reference reveals that this assertion is incorrect because *Czyszczewski* does not disclose or even reasonably suggest each and every element, either expressly or inherently, as set forth in Claim 11.

30 For example, as mentioned above, *Czyszczewski* fails to disclose *a unitary device* that includes *a optical scanning mechanism* as specifically recited in Claim 11. *Czyszczewski* clearly teaches that the scanner 20 is not part of a unitary device, but rather a separate, stand-alone device. In doing so, *Czyszczewski* actually teaches away from such a unitary device.

Czyszczewski also fails to disclose *a unitary device* that includes **a data storage mechanism configurable to access a removable data storage media** as recited in Claim 11. As pointed out above, it is unclear if the “one or more disk drives” as mentioned only on line 21 of column 6 by Czyszczewski do or do not include a data storage mechanism configurable to access a removable data storage media. Given this  
5 uncertainty, it seems unreasonable to assert that Czyszczewski somehow discloses or otherwise suggests the unitary device recited in Claim 11.

Again assuming for arguments sake that a “disk drive” in Czyszczewski’s multifunction controller 25 can be construed to include *a data storage mechanism*  
10 *configurable to access a removable data storage media*, it is nevertheless improper to assert that Czyszczewski somehow discloses or even suggests the unitary device as recited in Claim 11 having *logic that is “configured to selectively archive at least a portion of said electronic mail message data by providing said portion of said electronic mail message to said data storage mechanism for storage on said*  
15 *removable data storage device”*. Again, it is noted that Czyszczewski does not mention nor suggest that any data is written to the “disk drive” -- Czyszczewski only teaches that operating instructions for the CPU may be loaded from the “disk drive” into memory.

As presented above, with regard to electronic mail Czyszczewski teaches only that one of the functions that the multifunction controller 25 can support is that e-mails  
20 can be sent out through an e-mail port using “optional local services 135” and/or “optional global services 55”. Czyszczewski simply does not mention storing copies of the outgoing e-mails or any other types of data to the “disk drive” of multifunction controller 25.

Consequently, for at least these reasons, Claim 11 and Claims 12, and 16-20,  
25 which depend there from, are also patentable over Czyszczewski.

Dependent Claims 4-6, 10, and 13-15 stand rejected under 35 U.S.C 103(a) as being unpatentable over Czyszczewski in view of US Patent No. 6,810,404 issued to Ferguson et al. (Ferguson). Applicant traverses these rejections for at least the previous stated and/or following reasons and in doing so further respectfully requests that the

5 Examiner reconsider and withdraw the rejections too.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a

10 reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

15 *Czyszczewski* and/or *Ferguson*, alone or in combination, fail to disclose or suggest the method recited in dependent Claims 4-6, and 10.

For example, neither *Czyszczewski* and/or *Ferguson*, alone or in combination, disclose or suggest *a unitary device* comprising therein logic, a user interface, *a scanning mechanism*, a communication interface, and a removable data storage

20 mechanism. Fig. 1A of *Ferguson* clearly shows a general purpose computer 100 connected to a separate stand-alone scanner 105. *Czyszczewski* teaches that the scanner 20 is not part of a unitary device, but rather a separate, stand-alone device. Hence, both of these cited references, alone or combined, fail to disclose or otherwise suggest a unitary device including a scanning mechanism as specifically recited in the rejected

25 dependent claims. Indeed, as pointed out above *Czyszczewski* actually teaches away from such a unitary device. This fact appears to reduce if not completely remove any

requisite motivation that someone skilled in the art would review these references and somehow combine their teachings to render the pending claims obvious.

Furthermore, neither *Czyszczewski* and/or *Ferguson*, alone or in combination, disclose or suggest *receiving a removable data storage media in said removable data storage mechanism; selectively operatively coupling said removable data storage media to said logic; and storing at least an archival copy of at least said electronic mail message data sent via the communication interface on said removable data storage media.*

Thus, for at least these reasons, dependent Claims 4-6, and 10 are patentable over *Czyszczewski* and/or *Ferguson*, alone or in combination.

*Czyszczewski* and/or *Ferguson*, alone or in combination, also fail to disclose or suggest the unitary device recited in dependent Claims 13-15.

For example, neither *Czyszczewski* and/or *Ferguson*, alone or in combination, disclose or suggest *a unitary device comprising a data storage mechanism configurable to access a removable data storage media, an optical scanning mechanism, and logic configured to selectively archive at least a portion of said electronic mail message data by providing said portion of said electronic mail message to said data storage mechanism for storage on said removable data storage device.* Again, Fig. 1A of *Ferguson* clearly shows a general purpose computer 100 connected to a separate stand-alone scanner 105 and *Czyszczewski* teaches that the scanner 20 is not part of a unitary device, but rather a separate, stand-alone device. Hence, both of these cited references, alone or combined, fail to disclose or otherwise suggest the recited a unitary device. Indeed, as pointed out above *Czyszczewski* actually teaches away from such a unitary device. This fact appears to reduce if not completely remove any requisite motivation that someone skilled in the art would review these references and somehow combine their teachings to render the pending claims obvious.

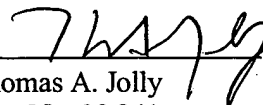
Thus, for at least these reasons, dependent Claims 13-15 are patentable over  
Czyszczewski and/or Ferguson, alone or in combination.

The pending claims are clearly allowable over the cited art and in a ready  
5 condition for prompt allowance.

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Respectfully Submitted,

  
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